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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,066	03/07/2002	Kouichi Takamine	10873.892USWO	8500
23552	7590	10/30/2003	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			BRAUN, FRED L	
			ART UNIT	PAPER NUMBER
			2852	

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,066

Applicant(s)

TAKAMINE ET AL.

Examiner

Fred L. Braun

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-6, 13, 17, 19, 20, 22-31, 34 and 36 is/are allowed.
- 6) ☒ Claim(s) 1, 14, 32, 33 and 35 is/are rejected.
- 7) ☒ Claim(s) 7-12, 15, 16, 18 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moro

As broadly as recited in the claims and disclosed by applicants in their specification, it is submitted that their claimed safety priority mode is defined as being a mode in which copyrighted image data or materials are being reproduced by an image forming apparatus.

Accordingly, it is submitted that it is obvious to one having ordinary skill in the art, upon perusal

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of column 1, line 19 through column 2, line 62 of Moro, that the claimed method steps of selecting either the performance or normal copying operation mode is selected and carried out by the device of Moro when the print key 14 is actuated and that the safety priority mode or copyrighted image data mode is selected or carried out when the print key 15 of Moro is actuated. With respect to claim 32, it is further submitted that is obvious to one having ordinary skill in the art that the apparatus of Moro is capable of performing the control method steps of claim 1.

5. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moro as applied to claims 1 and 32 above, and further in view of Ujiie et al.

The patent to Ujiie et al shows that it is well known in the art to provide an image forming device with a memory card receiving means 7 (Fig. 1A) which receives a portable storage medium or memory card 8 (Fig. 1A), as recited in claim 35, so that the various image formation modes stored in said memory card 8 can be input to the image forming device of same.

Therefore, to provide the device of Moro with a memory card receiving means so that a portable storage medium can be inserted into said memory card receiving means of the image forming device and thereby have the various image formation modes stored in said memory card input, as suggested by Ujiie et al, would be an obvious modification of the prior art to one having ordinary skill in the art at the time applicants invention was made.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obata.

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It is submitted that it is obvious to one having ordinary skill in the art that the patent to Obata (column 11, line 18 through column 12, line 65) suggests the broadly claimed control method of disabling the execution of the data printing when it is determined that the remaining amount of the recording media is not more than a predetermined limit (i.e. the number of copies requested) as a result of the detection that the remaining amount of recording media available in the size selected is not present in the paper cassettes.

7. The patents to Kuroyanagi et al, Clearwater and Connolly et al, respectively, are cited of interest to further show the obviousness of using different control methods for controlling the modes of operation of an image forming device.

8. Claims 7-12,15,16,18 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication should be directed to Fred L Braun at telephone number (703) 308-0128.

Fred L Braun

FRED L BRAUN
PRIMARY EXAMINER
ART UNIT 2852

F L BRAUN/ac

10/03/03